UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,000	11/29/2000	Erin M. Bourke-Dunphy	MS160277.1	9642

27195   7590   04/06/2004

AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST NINTH STREET
CLEVELAND, OH 44114

EXAMINER
GROSS, KENNETH A

ART UNIT	PAPER NUMBER
2122	4

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application 09/726,000	Applicant(s) BOURKE-DUNPHY ET AL.
Office Action Summary	Examiner Kenneth A Gross	Art Unit 2122

-- Th MAILING DATE of this communication appears on the cover sh et with th   correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 February 2004</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-35</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on February 4th, 2004.

2.   Claims 33 and 34 are now rejected under 35 USC 103(a) instead of 35 USC

102(e). Claims remain rejected under 35 USC 103(a) with augmentation added for

addressing the amended Claims 33-35.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Specifically, Claims 33 and 35 recite the term

"the system" on lines 3-4. There is a lack of antecedent basis for this limitation in the

Claim.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-14, 17-20, 22-24, and 27-32 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz

et al. (U.S. Patent Number 6,182,275).

In regard to Claim 9, Smith teaches: (a) providing dependency information

relating to at least one service pack (Column 2, lines 18-20) and (c) selectively installing

the service packs associated with an application component according to setup and

dependency information (Column 8, lines 18-21). Although Smith does not specifically

teach the step of installing the service pack, Smith does teach that the service packs are

for "installation on a computer system" (Column 2, lines 3-4), and hence the service

packs are obviously *going to be* installed on a computer system (Emphasis added –

regardless of what manner, e.g. automatic or manual). Smith does not teach prompting a

user for desired setup information relating to a desired setup for the computer system.

Beelitz, however, does teach generating a setup of a computer system based on user input

(Column 22, lines 42-52). Therefore it would have been obvious to one of ordinary skill

in the art at the time of the invention to provide dependency information relating to at

least one service pack and selectively install the service packs associated with an

application component according to setup and dependency information, as taught by

Smith, where the setup information is acquired by prompting a user for desired setup

information relating to a desired setup for the computer system, as taught by Beelitz,

since this allows service packs to be installed based on the applications that need them.

In regard to Claim 22, Beelitz teaches prompting a user for desired setup

information relating to a desired setup for the computer system (Column 22, lines 42-52)

and installing a service pack associated with a software component residing in a

computer system if the software component requires the service pack. Although Smith

does not specifically teach the step of installing the service pack, Smith does teach that

the service packs are for "installation on a computer system" (Column 2, lines 3-4), and

hence the service packs are obviously going to be installed on a computer system. Beelitz

teaches installing correctional patches, which are obviously required by some

applications to fix critical errors (Column 22, lines 42-52). Beelitz further teaches

installing a service pack if the setup information indicates that an upgrade component

corresponding to a software component is not to be installed. Beelitz teaches a setup

information which indicates application upgrade components to install. The upgrade

component that is not to be installed is any upgrade component not on the list of setup

information that is associated with the application component.

 For specific rejections of Claims 10-14, 17-20, and 23-24, see the office action

mailed on October 6th, 2003.

 In regard to Claims 1-7 and Claims 30-32, Claims 1-7 and Claims 30-32 are

system claims, which correspond with method claims. The combination of Smith and

Beelitz, in particular, teach a user interface (Column 22, lines 37-38), a data store (Figure

1, item 125), and an installation component (Column 28, lines 56-58), thus such system

Claims would also have been obvious. Claim 1 corresponds with Claim 9. Claim 2

corresponds with Claim 11. Claims 3 and 4 correspond with Claim 12. Claims 5-7

correspond with Claims 14-16 respectively. Claims 30-32 correspond with Claims 22-24

respectively.

 In regard to Claims 27-29, Claims 27-29 are medium claims, which correspond

directly with method claims. Beelitz teaches a user interface (Column 22, lines 37-38)

and an installation component (Column 28, lines 56-58). Claims 27-29 correspond directly with Claims 22-24, respectively.

7.   Claims 15, 16, 20, 21, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz et al. (U.S. Patent Number 6,182,275) and further in view of Curtis (U.S. Patent Number 6,442,754).

For specific rejections of Claims 15, 16, 20, 21, 25, and 26, see the office action mailed on October 6th, 2003.

8.   Claim 33-35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703).

In regard to Claim 33, Smith teaches generating a service pack based on system parameters and dependency information (Column 2, lines 1-41). Although Smith does not specifically teach the step of installing the service pack, Smith does teach that the service packs are for "installation on a computer system" (Column 2, lines 3-4), and hence the service packs are obviously installed on a computer system.

In regard to Claim 34, Smith teaches: (a) a first component for interrogating a system to identify installed software (Column 2, lines 5-7); (b) a second component for generating a service pack based on system parameters and dependency information (Column 2, lines 14-41). Although Smith does not specifically teach the step of installing the service pack, Smith does teach that the service packs are for "installation on a computer system" (Column 2, lines 3-4), and hence the service packs are obviously installed on a computer system.

In regard to Claim 35, Smith teaches generating a service pack based on system

parameters and dependency information (Column 2, lines 1-41). Smith does not explicitly

teach the service pack compacted and/or adapted within a data packet, however, the

examiner takes official notice that a service pack is commonly supplied over the Internet

and business networks, and is thus, obviously sent in the form of a data packet. Smith

does not specifically teach the step of installing the service pack, Smith does teach that

the service packs are for "installation on a computer system" (Column 2, lines 3-4), and

hence the service packs are obviously going to be installed on a computer system.

Response to Arguments

9.   Applicant's arguments filed February 4th, 2004 have been fully considered but

they are not persuasive.

Specifically, the applicant argues that Smith does not teach installing service

packs, merely ordering service packs for installation (Page 11). As stated in the above

rejections, although Smith does not specifically teach the step of installing the service

pack, Smith does teach that the service packs are for "installation on a computer system"

(Column 2, lines 3-4), and hence the service packs are obviously going to be installed on

a computer system.

The applicant further argues that Beelitz does not teach installing service packs on

computer systems as a function of desired setup and dependency information (Page 11).

While this is true, this is not the reason that the Beelitz reference is introduced. Beelitz

teaches prompting a user for desired setup information, which is an element missing from

Smith. The motivation for the combination of the two references lies in the selective

installation of computer components. While Smith teaches software computer

components, Beelitz teaches hardware computer components.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-

0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

KAG

TUAN DAM
SUPERVISORY PATENT EXAMINER